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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,997	10/12/2000	Olivier De Lacharriere	196726US0	5836
22850	7590	07/31/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,997

Applicant(s)

DE LACHARRIERE ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13,16-24,27-33 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) 36-45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23,24 and 27-33 is/are allowed.
- 6) ☒ Claim(s) 12,13,16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on May 22, 2006 has been entered.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12, 13, 16-19, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Orentreich (IDS).

Orentreich teach a method of treating skin condition by applying to the skin a composition comprising about 1% of DHEA or its derivatives and a keratolytic agent. See, particularly, the abstract, the examples, and the claims. Such treatment would have inherently lightening the skin. Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from inherent use, absent a *haec verba* recitation for such utility. In the instant application, as in *Ex parte Novitski*, supra, the claims are directed to depigmentation or lightening of skin with old and well known cosmetic compositions. It is now well settled law that administering compounds inherently possessing a therapeutic utility

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anticipates claims directed to such therapeutic use. Arguments that such therapeutic use is not set forth *haec verba* are not probative. Prior use for the same utility clearly anticipates such utility, absent limitations distancing the proffered claims from the inherent anticipated use. Attempts to distance claims from anticipated utilities with specification limitations will not be successful. At page 1391, *Ex parte Novitski*, supra, the Board said "We are mindful that, during the patent examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 219 (CCPA 1975)." In the instant application, Applicants' failure to distance the proffered claims from the anticipated therapeutic utility, renders such claims anticipated by the prior inherent use. Regarding the limitation "in need of depigmentation and/or bleaching" It is noted that such limitation would read on those who need to improve his/her skin homogeneity of color, and would be applicable to most of the people who are willing to use cosmetics. Who does not want to improve his/her skin homogeneity or color? It is particularly true for those who are exposed (or have been exposed) to intensive UV light.

Claims 12, 13, 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenbaum (US Patent 5,869,090).

Rosenbaum teaches a method of treating skin conditions by applying a composition comprising about 1% of DHEA to the skin. See, particularly, the abstract, examples 9-13 and claims 19 and 25. As discussed above, such treatment would have inherently lightening the skin. Regarding the limitation "in need of depigmentation and/or bleaching" It is noted that such

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limitation would read on those who need to improve his/her skin homogeneity of color, and would be applicable to most of the people who are willing to use cosmetics. Who does not want to improve his/her skin homogeneity or color? It is particularly true for those who are exposed (or have been exposed) to intensive UV light.

Claim Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12, 13, 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobuo et al. (JP 07196467, IDS submitted August 25, 2005) and Orentreich (4,542,129 of record), in further view of Tokue et al.

5. Orentreich teaches a method of treating skin condition (dry skin) by applying to the skin a composition comprising about 1% of DHEA or its derivatives and a keratolytic agent. See, particularly, the abstract, the examples, and the claims. Nobuo et al. teaches that DHEA stimulating the certification of cuticle and enabling to expected improvement in roughed skin and the prevention (suppression) in the aging of the skin (see the abstract provided in the IDS).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use the composition of Orentreich for general cosmetic purpose, such as improving the general condition of skin and suppression of the aging of the skin, since DHEA has been known to provide such benefit. The further incorporation of

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UV screening agents into the composition disclosed by Orientreich for the purpose of improving the general condition of skin and suppression of the aging of the skin would have been obvious to one of ordinary skill in the art, since it is well-known in cosmetic art that UV light is known as a factor causing the aging of skin and employment of UV screening agents, such as benzophenone derivatives, for suppressing skin aging is known in the art. See, e.g., the claims in Tokue et al. It is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is the employment of a combination of two known anti-skin aging agents sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. Regarding the limitation “in need of depigmentationand/or bleaching” It is noted that such limitation would read on those who need to improve his/her skin homogeneity of color, and would be applicable to most of the people who are willing to use cosmetics. Who does not want to improve his/her skin homogeneity or color? It is particularly true for those who are exposed (or have been exposed) to intensive UV light.

6. Further, it is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant’s attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated “is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” In the instant invention, the claims are directed to the ultimate

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utility set forth in the prior art, albeit distanced by various functions. The ultimate utility for the claimed compounds is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Response to the Arguments

In response to applicant's argument that the cited references do not teach or suggest depigmentation, or bleaching, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The "in need of" limitation recited herein fails to distinct the claimed invention from the prior art. Jansen case is misused in this situation. In Jansen, the population be treated by the claimed method in Jansen is clearly limited to a very specific population, i.e., "human which anemia is caused by ether folic deficiency or by vitamin B[12] deficiency." *Rapport* decision provides no help to applicants' position. In Rapoport, the claimed invention is directed to method of treating sleep apnea, and the reference teaches a method of treating anxiety caused by sleep apneas. The reference does not teach the treatment of sleep apnea. The actual method in the reference is different from the claimed invention in terms of the effective amounts and the timing for administration. See, pages 1061-1062. In instant application, the "in need of" limitation is "in need of depigmentation and/or bleaching" It is noted that such limitation would read on those who need to improve his/her skin homogeneity of color, and would be applicable to most of the

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people who are willing to use cosmetics. Who does not want to improve his/her skin homogeneity or color? It is particularly true for those who are exposed (or have been exposed) to intensive UV light.

Applicants further contend that the cited references do not necessarily possess the claimed properties inherently. The examiner disagrees. If a method directed to the employment of the same compound (DHEA), in the same concentration (see claims 16 and 17 herein and the examples in cited references), for treating the same population, any functions residing in the method would have been inherent and inevitable. The ultimate steps in claimed invention are identical to those disclosed in the prior art, i.e., applying a topical composition comprising DHEA to human skin. Therefore, the claimed method is clearly anticipated by the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
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